

Inventor: Bruce C. Johnson

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52. The dilator of claim 47 wherein said adhesive substance located on each of said pair of spaced apart surfaces is capable of adhering to a covering means while adhering to said truss prior to any engaging of exposed surfaces of wall tissues yet permitting said covering means to be manually removed therefrom.

REMARKS

This communication is in response to the Action of February 13, 1997 supplementing the Action of January 27, 1997. In this last Action, claims 1 through 22 have been rejected, and this rejection has been made final.

The applicant has amended claims 1 and 8 to clarify them, and has added claims 23 through 52 to more fully claim the present invention.

The Examiner first rejects claims 1 through 22 for double patenting on the grounds that the issuance of a patent on this application, containing claims broader than those in the patents listed as forming the basis for this rejection, will have the effect of extending the effective time of the claims in those listed patents past the expiration dates thereof. The applicant will take no action in this regard at this time in view of the further letter promised in the Examiner's Action concerning terminal disclaimers in this connection. Nevertheless, even though the Applicant previously filed willingly a Terminal Disclaimer with respect to the patent issuing on the application parent to the present one without regard to filing statuses of the patents and applications involved, in view of the applicant's lack of any intent to extend the effective time of the claims in that patent, the applicant cannot perceive the need for any terminal disclaimers of this nature nor the basis of the rejection. Under the present law resulting in expiration of a patent twenty years following its effective filing date, any patent issuing on the present application would appear to expire prior to the expiration of any of the listed patents forming the basis of this rejection. The applicant cannot see in either the Schneller case or in the guidance materials provided anything of relevance to this situation, but remains ready to do whatever is necessary in the circumstances to resolve this matter.

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The Examiner next objects to the specification under 35 U.S.C. § 112, and correspondingly rejects claim 8 thereunder, for the specification not disclosing dilators other than a nasal dilator but claiming more broadly just dilators. The applicant has amended claim 8 above, and so believes this objection and the accompanying rejection is overcome.

The Examiner then goes on to reject claims 8, 9, 11, 13, 17, 20 and 22 under 35 U.S.C. § 103 as being obvious in the face of U.S. Patent 1,292,083 to Sawyer. The Examiner appears to contend that the wire alone in Sawyer can serve as a truss of a single body with loop 6 in pads 5 of the Sawyer device together serving as the engagement means connected to the truss, with the Examiner apparently finding mechanical attachment the equivalent of adherence. However, there cannot be any such equivalence in view of the requirement of the Sawyer device to be able to mechanically disconnect the spring from the loops to allow adjustment of the spring force which would not be possible for an adhering attachment if the adherence properties are to be maintained.

Furthermore, the applicant must respectfully disagree with the Examiner's position that the declaration of the Chief Executive Officer of the licensee of the applicant's assignee, submitted with the last amendment, exhibits a lack of nexus between the subject matter claimed in claim 8 and the subject matter described in that declaration as providing the commercial success. Claim 8 requires a dilator with a truss exhibiting a restoring force capable of engaging the outer wall tissues of a user's nose against such a force without any details of the structure providing such a force. Such a restoring force is exactly what the product described in the declaration provides, and there isn't the slightest evidence or indication that consumers give any consideration to the details of the structure providing this force or that such details are part of their decision to purchase the product. In addition, the copying by competitors of the product described in the declaration in forming the products they have marketed has resulted in the competitors' products also being clearly within the scope of claim 8, and it is irrelevant as to whether they are making use of the principles set out in the limitations in claim 8 that there are also some additional construction details in their products, as there always will be except in situations of identical copies.

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However, in a telephone conversation with the Examiner on February 11, 1997, the applicant's attorney was given an indication that these issues would be moot if the entire dilator was claimed as a single body. Thus, the applicant has amended claim 8 above so as to incorporate this alternative formulation.

In correspondence with this concept of reciting the dilator as a single body, in view of the Examiner's position that the truss being recited as a single body is insufficient, the applicant has added claims to more fully claim the present invention. Thus, claim 23 has been added, along with claims depending thereon comparable to those depending on claim 8, with claim 23 being drawn as claim 18 in U.S. Patent 5,533,499 issued on the parent application except for omitting the limitation of the truss being a single body. Patentability of this claim follows since claim 18 in the '499 patent apparently was allowable without regard to the truss recited therein being a single body.

In addition, the applicant has added claim 38 with claims depending thereon that, again, are comparable to those depending on claim 8. Claim 38 recites the dilator being of a single body, as in present claim 8 following this amendment, and indicates that the engagement means is on the end surfaces as part of that single body but without requiring a particular way of making the engagement means part of that body.

Thus, claims 8, 23 and 38 contain limitations making them patentable but leaving them with the scope greater than the claims granted in patents issued on related applications as required by the Examiner in her Action. In addition, claim 1 has been amended to indicate that the truss member tends to return to an initial state rather than a substantially planar state, thus allowing the truss to have some initial curvature as a result of either manufacture or design. Hence, claim 1 is of a scope clearly differing from that of the claims in the patents granted on related applications.

In view of the foregoing, the applicant respectfully requests the Examiner to

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reconsider the rejections of the claims as amended, and further requests the claims now be allowed as amended along with the added claims.

Respectfully submitted,

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